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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/736,405	12/15/2003	William Sobonya	MAEE 2 00034	6233
27885	7590	03/22/2006		
FAY, SHARPE, FAGAN, MINNICH & MCKEE, LLP 1100 SUPERIOR AVENUE, SEVENTH FLOOR CLEVELAND, OH 44114			EXAMINER RUDDOCK, ULA CORINNA	
			ART UNIT	PAPER NUMBER
			1771	

DATE MAILED: 03/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	<b>Application No.</b> 10/736,405	<b>Applicant(s)</b> SOBONYA, WILLIAM	
	<b>Examiner</b> Ula C. Ruddock	<b>Art Unit</b> 1771	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 December 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-15 is/are pending in the application.  
     4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \* c) ☐ None of:  
         1. ☐ Certified copies of the priority documents have been received.  
         2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
         3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

1. The Examiner has carefully considered Applicant's response filed December 29, 2005. The objection to the claims and the double patenting rejection has been overcome. All prior art rejections have been maintained.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### ***Status Identifier***

3. It should be noted that the status identifier for Claim 15 is incorrect. It should read "Currently Amended" since the claim has been amended.

### ***Terminal Disclaimer***

4. The terminal disclaimer filed on December 29, 2005, disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of 6,911,406 and 10/736404 has been reviewed and is accepted. The terminal disclaimer has been recorded.

### ***Claim Rejections - 35 USC § 103***

5. Claims 1-4, 6, 7, 9, 10, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hawley et al. (US 6,130,174) in view of Hamilton et al. (US 2005/0112314). Hawley et al. disclose a laminate having nonslip characteristics. The laminate comprises a smooth film and a scrim (abstract). The scrim is woven plastic scrim (col 2, ln 56-58) coated by a polyvinyl chloride plastic (claim 1). A vinyl plastic film (col 3, ln 4-10) is laminated to the scrim via an adhesive (col 4, ln 40-42). The vinyl film has a thickness of .004-.008 inches, 4-8 mils (col 2, ln 5-7). Hawley et al. disclose the claimed invention except for the teaching that the laminate is embossed.

Hamilton et al. (US 2005/0112314) disclose a high bond strength, repositionable adherent sheet. The sheet material can be used in shelves [0034]. The sheet material can be embossed [0030 & 0072] on the front surface [0003]. It would have been obvious to one having ordinary skill in the art to have used Hamilton's embossing steps on the laminate of Hawley et al., motivated by the desire to create a laminate having a pattern or design on the surface.

It also would have been obvious to one having ordinary skill in the art to have made the textured finish to have a leather or linen-like appearance, motivated by the desire to create a laminate that blends in with its surroundings.

***Rejection is maintained.***

6. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hawley et al. (US 6,130,174) and Hamilton et al. (US 2005/0112314) as applied to claim 1 above, and further in view of Owen (US 5,874,371). Hawley et al. and Hamilton et al. disclose the claimed invention except for the teaching that the scrim comprises a non-woven scrim.

Owen (US 5,874,371) discloses a non-skid covering for use on a surface (abstract). The scrim comprises a PVC coated non-woven scrim (claims 5 and 6). It would have been obvious to have used Owen's coated non-woven scrim as the scrim in the laminate of Hawley et al. and Hamilton et al., motivated by the desire to create a laminate having cheaper processing costs.

***Rejection is maintained.***

7. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hawley et al. (US 6,130,174) and Hamilton et al. (US 2005/0112314) as applied to claim 1 above, and further in view

of Aliabadi (US 2003/0036323). Hawley et al. and Hamilton et al. disclose the claimed invention except for the teaching that the scrim is a polyester.

Aliabadi (US 2003/0036323) disclose a shelf liner comprising a top layer of a smooth polyvinyl chloride covering a sandwich layer of a polyester fabric between layers of polyvinyl chloride (abstract). A layer of polyester mesh fabric is between layers of polyvinyl chloride [0023]. It would have been obvious to have used the polyester mesh of Aliabadi in the laminate of Hawley et al. and Hamilton et al., motivated by the desire to create a laminate having the effects and properties associated with polyester.

***Rejection is maintained.***

8. Claims 11-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hawley et al. (US 6,130,174) in view of Hamilton et al. (US 2005/0112314) and Schottenfeld (US 2002/0094404). Hawley et al. disclose a laminate having nonslip characteristics. The laminate comprises a smooth film and a scrim (abstract). The scrim is woven plastic scrim (col 2, ln 56-58) coated by a polyvinyl chloride plastic (claim 1). A vinyl plastic film (col 3, ln 4-10) is laminated to the scrim via an adhesive (col 4, ln 40-42). The vinyl film has a thickness of .004-.008 inches, 4-8 mils (col 2, ln 5-7). Hawley et al. disclose the claimed invention except for the teaching that the laminate is embossed and that there is a protective removable covering on the laminate.

Hamilton et al. (US 2005/0112314) disclose a high bond strength, repositionable adherent sheet. The sheet material can be used in shelves [0034]. The sheet material can be embossed [0030 & 0072] on the front surface [0003]. Schottenfeld (US 2002/0094404) discloses a liner for covering a generally smooth surface comprising a PVC sheet [0019] and a PVC coated scrim

[0020]. A release layer is added to the liner [0024]. It would have been obvious to one having ordinary skill in the art to have used Hamilton's embossing steps on the laminate of Hawley et al., motivated by the desire to create a laminate having a pattern or design on the surface. It would have been obvious to have used the release layer of Schottenfeld in the laminate of Hawley et al. and Hamilton et al., motivated by the desire to create a laminate that has improved handling characteristics.

It also would have been obvious to one having ordinary skill in the art to have made the textured finish to have a leather or linen-like appearance, motivated by the desire to create a laminate that blends in with its surroundings.

***Rejection is maintained.***

#### ***Response to Arguments***

9. Applicant's arguments filed December 29, 2005, have been fully considered but they are not persuasive for the reasons set forth. Applicant argues that the adherent sheet material disclosed by Hamilton is not repositionable in the same sense as the embossed film of the present invention. This argument is not commensurate in scope with the claims because the claims do not require that the film be repositionable. Applicant further argues that Hamilton's selective activation process is temporary and therefore, prevents the sheet from being repositioned after final application. This argument is not persuasive because Hamilton specifically discloses that their sheet is repositionable. Furthermore, Applicant's specification and claims do not specify the period of time for which the sheet must remain repositionable. Finally, Applicant's claims do not preclude the use of selectively-activatable adhesives. Applicant further argues that Hamilton seems to only

teach or disclose embossing of the flexible sheet for the purpose of producing non-adhesive protrusions. This argument is not persuasive because the fact that Applicant uses embossing for a different purpose does not alter the conclusion that its use in a prior art product would be prima facie obvious from the purpose disclosed in the reference. *In re Lintner*, 173 USPQ 560.

Furthermore, Applicant's claims fails to set forth a specific reason for embossing. Applicant also argues that the flexible film sheet described by Hamilton does not correspond to the embossed vinyl film of the present invention. This argument is not persuasive because the Hawley reference was used for its disclosure of a laminate comprising a vinyl plastic film laminated to a coated scrim. The Hamilton reference was used for its disclosure of embossing and the references can be properly combinable because both Hawley and Hamilton are drawn to laminates for use as shelf liners. Therefore, all rejections have been maintained.

### ***Conclusion***

**10. THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ula C. Ruddock whose telephone number is 571-272-1481. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel H. Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

UCR *Ula Ruddock*

*Ula Ruddock*  
**ULA RUDDOCK**  
**PRIMARY EXAMINER**